

PATENT
USSN 09/721,506
TTC 015389-002616US
Geron 018/210c

REMARKS

The claims now added into this application are a second presentation of the claims entered into the application by way of the Preliminary Amendment filed December 7, 2001 (claims 21-52). Support for the new claims is explained in the remarks filed on December 7, 2001.

Renumbering of Claims

The undersigned understands from a telephone conversation with Examiner Sisson that the Substitute Specification filed on March 7, 2003 had the effect of canceling claims 21-52, and re-entering original claims 1-20, which were thus renumbered 53-72. Accordingly, the Restriction Requirement mailed on October 2, 2003, should refer to claims 53-72.

All previous claims have been cancelled, and the re-presented claims are renumbered starting at claim 73, the next available number.

Election of Group for Examination

Claims 53-72 were previously in this application, and subject to a Restriction Requirement under 35 USC § 121 between claims in six groups. The new claims fall within the groups of the Restriction in the following manner:

- Group I: Claims 73-74, 81-82, 89-90, and 97-100
- Group II: Claims 75-78, 83-86, 91-94, and 101-104
- Group III: (no claims)
- Group IV: Claims 79, 87, and 95
- Group V: Claims 80, 88, and 96

Group II (the polynucleotide claims) is hereby elected for examination on the merits, without traverse.

Request for Rejoinder

Applicants respectfully request that all the claims in the application be rejoined into the group under examination, since the relevant subject matter has already been searched in the priority applications.

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This application claims priority to USSN 08/854,050, which issued as U.S. Patent 6,261,836 on July 17, 2001. The issued patent contains claims falling within groups I, II, and IV of the present Restriction. Accordingly, claims to polypeptide of the human telomerase catalytic subunit (SEQ. ID NO:2) and variants thereof, and polynucleotides encoding TRT and such variants have already been fully searched.

A copy of the claims from the issued patent accompanies this response for the Examiner's convenience.

Claims for Group I in the present application (the protein claims) differ from those of the issued patent mainly with respect to indication of particular characteristics of the claimed variants and fragments of telomerase protein (claims 73, 81, and 89). The characteristics should not complicate the prior art search beyond what was conducted for the priority application. As before, the polynucleotides claimed in Group II of this application are defined by the polypeptides they encode (Group I).

MPEP § 803 prohibits the Office from restricting different embodiments of an invention where there would be no burden on the Examiner to examine the claims together — irrespective of whether the embodiments are patentably distinct. Since the claims in Groups I and II have already been fully searched, it is not unduly burdensome to examine these claims together.

Furthermore, Group IV claims a process for using telomerase protein, depending from and incorporating limitations of the polynucleotide of Group I. Newly presented Group V claims a process for using telomerase polynucleotide, depending from and incorporating limitations of the polynucleotide of Group II. Both these groups of process claims are rejoinable with the product claims from which they depend upon determination that the product claims are patentable, in accordance with MPEP § 821.04.

For ease of prosecution and examination, applicants urge the Examiner to rejoin Groups I, II, IV, and V into the group under examination as early as possible.

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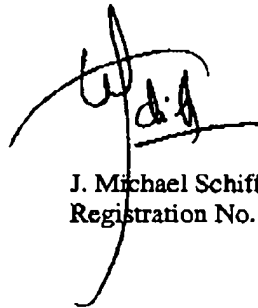
Conclusion

Applicants respectfully request that the application proceed to examination on the merits, in view of the amendment and remarks made herein.

In the event the Examiner determines that an interview would facilitate prosecution of this application, he is invited to contact applicants' representative at the telephone number indicated below.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicants hereby petition for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Michael Schiff', is written over a horizontal line.

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